REMARKS

Upon entry of the instant amendment, Claims 1, 6 and 8-9 will remain pending in the above identified application and stand ready for further action on the merits.

The specification has been amended herein at page 1, line 1 to insert a cross-referencing paragraph.

The amendments to the claims made herein do not incorporate new matter into the application as originally filed, including the description and original claims thereof. For example, support for the amendments made herein to claim 1, occurs in original claims 3-4 (now cancelled), support for the amendments made herein to claim 6, occurs in original claims 1 and 3-4, and support for newly added claims 8-9 occurs in original claim 2.

The amendments made herein to the claims do not raise substantial new issues for the Examiner's consideration and/or require any further search on the Examiner's part. Likewise, the amendments put the claims in a proper format for issuance in a United States patent and/or help to remove issues for purposes of appeal, so that entry thereof at present is entirely appropriate under the provisions of 35 USC § 116.

Disclosure Objection

The USPTO has objected to the instant disclosure for not containing continuing data. The specification is amended herein at page 1 to insert this data. Withdraw of the objection to the disclosure is thus respectfully requested.

Claim Rejections – 35 USC § 103(a)

Claims 1-7 have been rejected under 35 U.S.C. §103(a) as being unpatentable over the following six (6) different combinations of references:

1. US 6,068,787 (**Grumbine**)
2. US 2001/0049913 (**Miyata**)
3. US 6,316,366 (**Kaufman**)
4. US 6,436,834 (**Lee**) in view of **Grumbine**
5. US 6,585,786 (**Tsuchiya**) in view of US 6,309,434 (**Ohashi**)
6. WO 01/12740 (**Cabot**) in view of **Grumbine**

Reconsideration and withdraw of each of the above rejections are respectfully requested based on the following considerations.

Legal Standard for Determining Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet,* 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab,* 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee,* 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Distinctions Over the Cited Art

As pointed out by the Examiner, the polishing composition used in the present invention comprises components, the kinds of which are similar to those used in the cited art being applied against claims 1-7. Nonetheless, the processes and methods of the present invention as recited in pending claims 1, 6 and 8-9 are *not* obvious over the cited references in that the polishing compositions used in the instant processes and methods, which satisfy the following two requirements *(a)* and *(b)* can be advantageously used to reduce fine scratches.

(a) 0.2 mg KOH/g $\leq$ acid value (Y) $\leq$ 20 mg KOH/g

(b) Y (mg KOH/g) $\leq 5.7 \times 10^{-17} \times X$ (/g) + 19.45 (wherein X is the concentration of the abrasive in the polishing concentration on a numerical basis.)

The USPTO asserts that the polishing compositions of the cited references can also satisfy the above requirements. *However, this assertion is incorrect*.

In the cited references, the polishing compositions are disclosed equally, regardless of whether they satisfy or fail to satisfy the above requirements. For example, according to the teachings of the cited references, one of ordinary skill in the art would believe that the polishing compositions of comparative examples 1, 2, 3 and 6 in the present application would be equivalent to those of examples 1-10 of the present application, in the instantly claimed processes and methods. However, this is clearly *not* the case as can be seen upon reviewing the instant application.

Accordingly, because it is *not* acknowledged in any of the cited art references that a polishing composition satisfying the above requirements *(a)* and *(b)* is superior to a composition not satisfying such requirements, in the context of the instant inventive processes and methods, and because there is *no* disclosure or teaching in any of the cited art references that would allow one of ordinary skill

in the art to arrive at the instant invention as claimed or the superior results that are associated therewith, the present invention as claimed cannot be rendered obvious by the teachings of the cited art references of record.

It is the present inventors who have firstly discovered the present inventive processes and methods, wherein a polishing composition is selected satisfying the above requirements *(a)* and *(b)*, so as to thereby provide the unexpectedly advantageous property of reducing fine scratches imparted to a substrate during a polishing operation, etc. As such, it follows that the instant inventive processes and methods, which have these unexpected and advantageous results associated therewith, are incapable of being rendered obvious by the cited art of record, whether such cited art references are considered singularly or in combination. Any contentions of the USPTO to the contrary must be reconsidered.

Provisional Obviousness-Type Double Patenting Rejections

Claims 1-7 have been provisionally rejected on the ground of obviousness-type double patenting over the following four (4) United States Patent Applications:

SN 10/726,581

SN 10/857,841

SN 10 727,571

SN 10/753,460

Reconsideration and withdraw of each of these provisional rejections are respectfully requested based on the filing concurrently herewith of an appropriate terminal disclaimer(s), thereby obviating the provisional rejections.

Conclusion

Based on the amendments and remarks presented herein the Examiner is respectfully requested to issue a notice of allowance in the matter of the instant application, indicating that each of pending claims 1, 6, 8 and 9 is allowed and patentable under title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned, at the telephone number indicated, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By _____
John W. Bailey, #32,881

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

JWB/RG/lc
1422-0595P

Enclosures: Terminal Disclaimer(s)